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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,978	02/15/2002	Edward Sax	F-8040	1405

7590 12/09/2003

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EXAMINER

FLANDRO, RYAN M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 12/09/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/076,978

Applicant(s)

SAX ET AL.

Examiner

Ryan M Flandro

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2003 and 10 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 and 19-44 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16, 19, 27, 28, 30, 31, 33-35 and 38-44 is/are rejected.
- 7) ☒ Claim(s) 20-26, 29 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 November 2003 has been entered. The arguments submitted 12 September 2003 have been considered therewith and a response appears below.

#### ***Specification***

3. In view of Applicant's arguments (see paper no. 13) submitted 12 September 2003 and amendments (paper no. 18) submitted 10 November 2003, the objections to the specification are hereby withdrawn.

#### ***Drawings***

4. The objections to the drawings are withdrawn in view of Applicant's submission of Figure 1B showing the wires being cut (or having free ends) between said end fence posts and said ratcheting posts compressing said wire lathe.

***Claim Objections***

5. Applicant is again advised that should claims 16 be found allowable, claim 35 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Likewise, Applicant is advised that should claim 38 be found allowable, claim 39 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Applicant should note that the recitation “an intermediate fence system” (claims 16 and 38) and “a fence system” (claims 35 and 39) have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

***Claim Rejections - 35 USC § 112***

6. The rejection of claims 31, 33, and 36-39 under 35 U.S.C. 112, first paragraph, is hereby withdrawn in view of Applicant’s arguments submitted 12 September 2003.

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7. The rejection of claim 29 under 35 U.S.C. 112, second paragraph, is hereby withdrawn in view of Applicant's amendment submitted 10 November 2003.

***Claim Rejections - 35 USC § 103***

8. Claims 16, 19, 27, 28, 30, 31, 33-35, and 38-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bunch (US 355,135).

a. Claims 16, 35, 38 and 39. Bunch shows and discloses an (intermediate) fence construction system, comprising a plurality of fence posts **1** including end fence posts; a ratcheting (tensioning) system **2** including at least two temporary ratcheting (tensioning) posts **C** (as attached to a piece of wood – see column 1 lines 42-43 and column 2 lines 84-86), at least one of the ratcheting posts **C** having a plurality of fastening locations **B**; a plurality of ratchets (tensioners) (comprised of **A,D,E,F,G**, hereinafter denoted by “**D**”) secured at least at some of said fastening locations **B**; a plurality of high-tension tensile wires **3** running between said temporary ratcheting posts **C** and secured to the plurality of fence posts **1**, at least one end of each of said high-tension tensile wires **3** being connected to a respective one of said ratchets **D**, said high-tension tensile wires **3** being tensioned to a pre-determined tension by actuating said ratchets **D**; a lath **4** secured to said plurality of tensioned high-tension tensile wires **3** and said fence posts **1** (via wires **3**); and said high-tension tensile wires **3** being *cut* (read broadly to mean separation, removal, or division<sup>1</sup>) between said end fence posts **1** and said ratcheting posts **C** compressing said lath (the lath **4** is compressed in the tensioned wires **3** as shown in

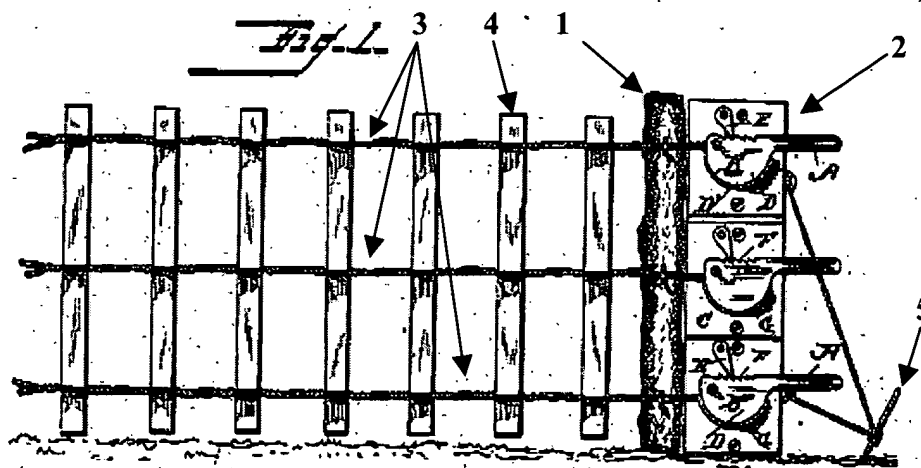
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<sup>1</sup> Webster's New World Dictionary of the American Language, Second College Edition, 1980 (emphasis supplied).

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figure 2). (See annotated figure 1 below and figure 3; column 1 line 44 – column 2 line 64).

Bunch fails to disclose the lath 4 being a *wire* lath. Bunch only discloses wood strips 4 secured to the high-tension tensile wires 3. Wire and wood lath are well-known art recognized equivalents. Lath is commonly defined as “any of the thin, narrow strips of *wood* used in building lattices . . . at a groundwork for plastering” and/or “any framework for plaster, as *wire* screening....”<sup>2</sup> Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute wire lath for the thin strips of wood disclosed by Bunch in as much as they are art-recognized equivalents.



b. Claim 19. Bunch, as set forth above, lacks said lath being metal as well as that said high-tension tensile wires and the wire lath are galvanized. Again, wire and wood lath are well-known art recognized equivalents. Also, it has generally been recognized,

<sup>2</sup> Id.

that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). The use of galvanized metal for tensioned wires and wire laths is well known. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to use a galvanized metal material to construct the tensioned wires and wire lath of Bunch as such practice is a design consideration within the skill of the art.

c. Claim 27. Bunch does not *expressly* include a pre-constructed non-structural decoration column. Applicant's admission in the Amendment filed 07 February 2003 (paper no. 9, page 8, second full paragraph) that the decoration column has "no structural function for the fence" is noted and the Examiner has, therefore, not given this recitation any patentable weight. Ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

d. Claim 30. Bunch further shows at least one supporting post **5** for supporting at least one of the ratcheting posts **C** (see annotated figure 1 above).

e. Claim 28. Bunch, as applied above, includes a fence comprising a plurality of fence posts **1**; a plurality of high-tension tensile wires **3** secured to the plurality of fence posts **1**, said high-tension tensile wires **3** being tensioned to a predetermined tension and having free ends (after the ratcheting posts **C** are removed); a lath **4** secured to the plurality of high-tension tensile wires **3** and said fence posts **1** and being compressed by said high-tension tensile wires **3** (see annotated figure 1 above). As above, Bunch fails to

disclose the lath 4 being a *wire* lath. Bunch only discloses wood strips 4 secured to the high-tension tensile wires 3. Wire and wood lath are well-known art recognized equivalents. Lath is commonly defined as “any of the thin, narrow strips of *wood* used in building lattices . . . at a groundwork for plastering” and/or “any framework for plaster, as *wire* screening....”<sup>3</sup> Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute wire lath for the thin strips of wood disclosed by Bunch in as much as they are art-recognized equivalents.

f. Claims 31 and 33. Bunch shows the lath 4 defining an unsupported bottom (see Bunch annotated figure 1 above).

g. Claim 34. The combination of Bunch, Miller, and Waggoner, as applied above, includes said fence posts 1 including end fence posts and said high-tension tensile wires 3 being unattached beyond said end fence posts 3 (see annotated figure 1 above). The Examiner notes that the wires 3 are secured to the end posts 1 “before releasing the wire from the stretcher” (Bunch column 2 lines 80-82). This is taken to mean that there is excess wire beyond the securing point on the end post 1, thus meeting the claimed limitation.

h. Claims 40-44. Bunch clearly shows said lath 4 directly secured to said plurality of tensioned high-tension tensile wires 3 and said fence posts 1 (see annotated figure 1 above). As above, Bunch fails to disclose the lath 4 being a *wire* lath. Bunch discloses wood strips 4 secured to the high-tension tensile wires 3. Wire and wood lath are well-known art recognized equivalents.

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<sup>3</sup> Id.



***Response to Arguments***

9. Applicant's arguments, see paper no. 13, filed 12 September 2003, with respect to the rejection(s) of claim(s) 16, 19-35, 38 and 39 under 35 USC §103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bunch *alone*.

10. Particularly persuasive is Applicant's argument at page 26 of paper no. 13. The Examiner agrees that the inventive concept described in the first full paragraph on that page is not disclosed in the prior art of record. In response, it is noted that the features upon which applicant relies (i.e., the compression of the wire lath *and* the fence coating material) are not recited in the now rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). This subject matter is recited in claims 20-26, 29 and 32, which are indicated as allowable below.

***Allowable Subject Matter***

11. Claims 20-26, 29 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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12. The following is a statement of reasons for the indication of allowable subject matter: the prior art, including Bunch, Miller, and Waggoner, either alone or in combination, fails to disclose high tension tensile wires compressing a fence coating together with said wire lath.


*Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan M Flandro whose telephone number is (703) 305-6952. The examiner can normally be reached on 8:30am - 5:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

RMF  
December 4, 2003

  
**Lynne H. Browne**  
*Supervisory Patent Examiner*  
**Technology Center 3670**